APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,693	08/04/2006	Mario A Villena	56290-1541	2279

20529 7590 09/05/2007		EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/536,693	VILLENA ET AL.
	Examiner	**Art Unit**	
	Dennis Ruhl	3629	-

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *32-58* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *32-58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____ .

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

Applicant's preliminary amendment of 4/25/06 has been entered. Currently claims 32-58 are pending.

With respect to the Petition to Make Special and the references mentioned therein, the examiner notes that applicant has never made these references "of record" in this application. Just mentioning them in the Petition to Make special does not result in making them "of record" in this application. An IDS (i.e. form 1449) or a listing of the cited references for the examiner to initial off on, is required if applicant wants them to be considered. To date, these references are not of record. Applicant may want to consider the filing of an IDS statement to make the references of record, unless they are cited back to applicant by the examiner in this office action. With respect to the "Realtor Workstation" NPL reference, the copy submitted with the Petition to Make special is difficult to read for many of the captured screenshots. If an IDS is submitted citing this reference, applicant is requested to provide a better copy so that the examiner can read it and understand the scope of the disclosure related to this document. The copy submitted with the Petition is not readable to a point where the examiner can understand what is fully discloses. Applicant's cooperation in this matter is appreciated.

1.   The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: It does not identify the citizenship of each inventor. The citizenship for inventor Jose Villena has not been identified

in the Oath. The citizenship block for Jose Villena has been left blank.

Correction is required.

2.   The disclosure is objected to because of the following informalities: On pages 8-9

and pages 14-15, applicant has attempted to incorporate by reference another pending

application filed by the co-inventors of the instant application. No filing date was

provided to assist in identifying these applications and upon a review of the pending

cases that the same inventors have filed at the USPTO, none of them match the titles

given on pages 8-9 or 14-15. With respect to the application mentioned on pages 8-9,

the examiner cannot find any application that has this title, not even anything close. It is

not at all clear as to what application this is referring to. With respect to pages 14-15,

there is no other pending case filed by Mario Villena and Jose Villena that has the title

of "Computerized systems for formation and update of property databases". Upon a

review of internal PTO data relating to currently pending applications, the examiner

could not locate another case with this same title. There is another case pending

(10/536692) that is entitled "Computerized systems for formation and update of

databases", but this title is missing the word "property", so it cannot be assumed that

this is the same application that is being referred to on pages 14-15. If applicant intends

to amend the specification to refer to 10/536692 or to another unknown application for

pages 8-9, the examiner requests an explanation as to why this would not constitute

new matter to the specification. The main concern of the examiner is that there appears

to be no other pending applications filed by the co-inventors that has the same titles as

referred to on pages 8-9 and 14-15. The '692 application has a similar title but it is not

the same, so the examiner is inclined to believe that amending the specification to refer

to the '692 application would be new matter. The examiner informs applicant of this

issue so that it may possibly be pre-empted with persuasive arguments, so as to

expedite prosecution.

Appropriate correction is required.

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

4.   Claims 37,40,48,51,55,58 are rejected under 35 U.S.C. 101 because they are

reciting method steps directed to doing manipulative acts. This is not proper because

the pending claims are apparatus claims, not method claims. Claim 40,48,51,55,58,

recites a method step of how the AVM value is being provided to the user (via a large

AVM database) or how it is generated (AVM or the AVM information item). This renders

these claims as non-statutory. This is because these claims are mixing both distinct

statutory classes of invention of an "apparatus" and a "method". In apparatus claims,

any recitations directed to actually doing method steps renders the claims as non-

statutory. As these claims are written, they are reciting a method step of providing the

AVM values, which renders the claims as non-statutory. Ex parte Lyell 17 USPQ2d

1548 (Bd. Pat. App. & Int 1990) ; IPXL Holdings, L.L.C. v Amazon.Com, Inc., 430 F.3d

1377, 1384 (Fed. Cir. 2005).

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6.   Claims 36,37,39,40,48-51,55,58, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 36,49,50, the claims are considered to be indefinite. For claim 36, the scope of the claim language "wherein the user-provided search parameters includes one or more parameters *related to* a differential valuation amount or differential valuation percentage." is not clear. This is because it is not known what this language includes and excluded as far as parameters go. What does it mean to recite that the parameters <u>are related to</u> a differential valuation, or related to the data of claims 49 and 50. What kind of data does this refer to? One wishing to avoid infringement would not know what kind of parameters would be infringing and what kind of parameters would not be infringing the scope of this claim, because it is not knows what constitutes data that is "related to" and what kind of data is not related to the claimed information. The claims are indefinite for this reason.

For claim 39, applicant has claimed that at least one report is provided to a set of subsequently sent user-provided search parameters. What does this add to the system that is being claimed? What is meant by reciting that a report is sent to a parameter? A parameter is a piece of data that does not have the ability to even receive anything. This makes no sense. It is not clear as to what is being claimed in this claim. The

examiner has no idea what applicant is attempting to claim in claim 39. The claim is

indefinite.

For claims 37,40,48,51,55,58, one wishing to avoid infringement would not be

reasonably made aware of the scope of the claimed invention. It is not clear if just

having the claimed structure of the system would be infringement, or if one would need

to have the claimed system and provide the AVM values in the manner that is claimed

to be infringing. This renders the claim as indefinite. Ex parte Lyell 17 USPQ2d 1548

(Bd. Pat. App. & Int 1990) ; IPXL Holdings, L.L.C. v Amazon.Com, Inc., 430 F.3d 1377,

1384 (Fed. Cir. 2005).

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8.   Claims 32-44,48-58, are rejected under 35 U.S.C. 102(b) as being anticipated by

Foretich et al. (20030191723).

For claims 32,33,39 (as best understood), 40,49,50,51,56,57, Foretich discloses

a system and method for determining *AVM values* for properties, such as residential

properties. Foretich determines valuation values by using a computer program

contained on a server, see paragraph 26. Foretich discloses that customers use remote

terminals 10,20 (or other types of communication devices) to access the property

valuation system via the Internet 50. See paragraph 25 where this is disclosed. The

remote terminals are *input devices* that allow the input of data to occur. Foretich

satisfies the language about "search parameters" because the language "search" lends

no further structure to the term parameters. Foretich takes in data from users, which

satisfies the term "parameters". Also, when identifying a property by tax number or

address, the system does search for the data relating to that property. The data

inputted in Foretich are parameters relating to properties. Foretich then prepares and

outputs reports to the users, where the reports are based on the inputted data from the

user, and the report contains an AVM value. This satisfies what is claimed. Figure 7

shows an example of a report. Foretich also discloses in paragraph 40, that batches of

queries can be submitted to be done at one time. The result of this would be that there

is a plurality of reports being provided that all contain an AVM value for each property.

This satisfies what is claimed. The examiner also believes that the entire content of the

report itself is directed to non-functional descriptive material and arguably constitutes

printed matter in an apparatus type of claim. There is nothing in the claims that is

manipulating any data to arrive at any new data. The query may simply be the request

for previously stored data that is stored in a database. In this case, all that is being

done is the output of this data that was previously stored. This involves no functional

relationship between the data and the system itself; the data is just retrieved and output. This does not result in the data being functional descriptive material.

For claims 33-35, as stated with respect to claim 32, the entire content of the report itself is directed to non-functional descriptive material and arguably constitutes printed matter in an apparatus type of claim. Foretich satisfies what is claimed.

For claims 33, in addition to that stated immediately above, Foretich does disclose that the report contains an AVM value that is the result of and conforms to the inputted parameters from the user.

For claims 36,37,49,50, the examiner notes that the actual parameters entered by the user are not part of the system and are not even a real world tangible thing. Reciting that the entered parameters include parameters related to a differential valuation or a differential valuation percentage defines nothing further to the structure of the system. The same is true for claims 49 and 50.This language appears to be nothing more than further non-functional descriptive material. The parameters are not part of the system and the parameters do not appear to be functional data. Foretich satisfies what is claimed. For claim 37, Foretich discloses that the user can enter a zip code. A zip code identifies a geographic region as claimed. Inherently, the zip code will identify an area that has properties for sale. As an example, if one were to enter the zip code of 13760, one would find that this refers to Endicott, New York, where there is a plurality of properties for sale. Also, the limitation of the geographic region having properties for sale defines nothing further to the system that is being claimed. This is more non-functional descriptive material that does not serve as a limitation.

For claim 38, when a user submits a query in Foretich, it is clearly received and is inherently going to be stored in a memory as claimed. The storage in memory may be temporary, but the system must necessarily store the data (even in a temporary buffer of memory) so that the system knows what the user is asking for and can process the request. With respect to the language reciting that the system is configured to generate a plurality of reports at different times, this is inherently found in Foretich. A user can simply request a new report every 3 months. This satisfies what is claimed. The system of Foretich is fully capable of producing a plurality of reports at different times. This capability is necessarily present in Foretich. All a user has to do is instruct the system to generate a new report for a given property, and do this more than once. This satisfies what is claimed.

For claims 41,42, the claimed notification device is satisfied by the fact that Foretich has a data output capability. This requires structure such as databus and/or a modem of some kind to allow data communication to occur over the Internet. This satisfies what is claimed. With respect to what the notification agent is to inform the user about, this is non-functional descriptive material that does not serve as a limitation. This is just the intended use of the notification agent. For claim 42, Foretich is connected to the Internet. That means that the notification agent is fully capable of sending an email as claimed. Also, applicant is referred to paragraph 36 where it is disclosed that the system of Foretich is configured to send email messages and other communication protocols. This satisfies what is claimed.

For claims 43,44, the claimed information device that is configured to provide information to the user is considered to be the display device of the terminals that the user uses to submit the query and view the results. This is the structure that provides the information to the user once it has been received from the AVM system. The display is inherently fully capable of providing an email to the user. Applicant is referred to paragraph 36 where it is disclosed that the system of Foretich is configured to send email messages and other communication protocols. This satisfies what is claimed because once it is received at the user terminal, the display is going to display it to the user (i.e. provide it).

For claims 48,51,55,58, the manner by which the AVM value (or AVM information item) has been generated is not defining any further structure to the claimed system. This claim is directed to a method step of how the AVM value was generated, which has nothing to do with any structure of the system. Claims 48,51,55 are directed to a method of use limitation, that does not receive patentable weight in an apparatus claim. Foretich satisfies what is claimed.

For claim 52, Foretich discloses that there are more than one class of users for the system. People such as a vice president or other senior employees may have different functions available to them than a regular loan officer would have. See paragraph 28. When being used by a loan officer, the system is operating in an agent mode as claimed. The term "Agent mode" is very broad and really means nothing specifically.

For claim 53, Foretich discloses a system that is used "on-line". When using the

Internet, it would be fair to say that the operation is being done "on-line".

For claim 54, defining the user and who they are or who they are not defines

nothing further to the claimed system. This is non-functional descriptive material that is

just describing a kind of individual that may be able to use the system. This defines

nothing to the system that is not already recited in claim 51.

9.   Claims 32-38,40,43,48-58, are rejected under 35 U.S.C. 102(b) as being

anticipated by Tornetta (5032989).

For claim 32-36,43,49,50,51,52,53,56,57, Tornetta discloses a computer based

system for performing property related searches based on search parameters provided

by the user. Tornetta discloses an input device that is configured to receive search

parameters from a user. The input device is the hardware of the system that receives

data from the telecommunication links 20 (i.e. modem, databus, etc.). Tornetta receives

information regarding search parameters and this requires an input device so that the

host computer 200 ultimately receives the data. The query device is the database

search hardware and software that allows for and conducts search queries with

generated results. The host computer 200 searches property files that are stored in a

database and outputs a report of the results as claimed based on the inputted search

parameters. See column 8, lines 34-41. The results are based on the inputted search

parameters as claimed. With respect to the language reciting the content of the report,

because the claim is written with a scope that allows for the mere retrieval and output of

stored data, the content of the report is considered to be non-functional descriptive

material. The report itself is not part of the structure of the system. Because the report

can be simply outputting data from files, where the data was previously stored, this is

just a computer based database searching system. The kind of data that the system

stores and searches is not going to define over the prior art. To give weight to the kind

of data being stored and searched would potentially result in hundreds of patents being

issued for a system that has an input device and a query device as claimed, where the

only differences are the kind of data being searched and outputted. One could then

feasibly obtain a patent for a system for searching cookie recipe files, and another

person can obtain a patent for a system for searching baby names. The data that is

being searched, if that is the only difference, is not going to be a patentably

distinguishing feature. Applicant is essentially claiming a computer system that allows

searching of files, which is anticipated by Tornetta. The content of the report is non-

functional descriptive material that does not serve as a limitation. The same is true for

claims 33-35.

For claim 37, Tornetta discloses that a user first identifies a geographic region.

See column 4, lines 38-end.

For claim 38, Tornetta discloses that the system receives and then stores user

provided search parameters. See column 10, lines 4-6. The system of Tornetta is fully

capable of performing updates searches at different times. All one has to do is rerun a

search and obtain a new report. This ability is found in Tornetta. Also, Tornetta

discloses that one can update a search file, so this clearly indicates that the file can be

updated and rerun at a later time. This satisfies what is claimed. As stated previously, the content of the report is considered to be non-functional descriptive material.

For claims 40,48,51,55,58, because the content of the report is non-functional descriptive material, it does not define any further structure to the system to recite the manner by which the AVM value was generated. The claim scope allows for the AVM value to just be retrieved from memory and outputted. This is non-functional descriptive material.

For claim 52, the term "agent mode" is very broad and really means nothing specifically. Tornetta satisfies what is claimed because the system can be used by a buyer (agent mode as this term is broad).

For claim 54, defining the user and who they are or who they are not defines nothing further to the claimed system. This is non-functional descriptive material that is just describing a kind of individual that may be able to use the system. This defines nothing to the system that is not already recited in claim 51.

For claim 56, Tornetta teaches that there is a database that stores property related data. Because all that is being done is the retrieval and output of data from a database, the data being stored and output is non-functional descriptive material.

10.   Claims 32,43,45-47, are rejected under 35 U.S.C. 102(e) as being anticipated by Florance et al. (20040030616).

Florance discloses a real estate system that provides users with real estate information in response to search queries submitted by users. The users utilize an input

device to submit search queries to a query device (processor/software that performs the searching based on the query). The query results are displayed to the user in the form of maps, as is disclosed in paragraphs 347 and 348, and shown in figure 58. This involves the use of an "information device" as claimed. These paragraphs disclose that the displayed maps allow for the display of the location of the property on a map by the use of icons and other indicators. Paragraph 348 states that when the user positions the computer mouse over an icon (that represents a property), *the system displays a pop-up window providing information on the associated property* (as best understood this satisfies "embedded"). It is also disclosed that this feature allows the user to view the overall region in which the property is location (a desirable feature), as well as the ability to zoom in and out on the map of the property (another desirable feature). With respect to the language reciting the content of the report, because the claim is written with a scope that allows for the mere retrieval and output of stored data, the content of the report is considered to be non-functional descriptive material. The report itself is not part of the structure of the system. Because the report can be simply outputting data from files, where the data was previously stored, this is just a computer based database searching system. The kind of data that the system stores and searches is not going to define over the prior art. To give weight to the kind of data being stored and searched would potentially result in hundreds of patents being issued for a system that has an input device and a query device as claimed, where the only differences are the kind of data being searched and outputted. One could then feasibly obtain a patent for a system for searching cookie recipe files, and another person can obtain a patent for a

system for searching baby names. The data that is being searched, if that is the only

difference, is not going to be a patentably distinguishing feature.

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

13.   Claims 34,35, are rejected under 35 U.S.C. 103(a) as being unpatentable over

Foretich et al. (20030191723).

For claim 34, if weight is to be given to the kind of data contained in the report,

then Foretich does not disclose that the report also contains the "offer price". The

examiner notes that the term "offer" is just descriptive of the price and that a price is a

price. Also, the offer price for a home can and sometimes is the same price as the sale

price. Claim 34 is interpreted to just further recite a price, the term "offer" lends not

further structure to "price". Also, a price is just a price. What it represents does not

change the fact that is just a number in a report. A number is a number, what you call it

does not change the fact it is still a number. In view of this, it would have been obvious

to one of ordinary skill in the art at the time the invention was made to provide the report

that is generated in Foretich with the offer/sale price of the property that is being

valuated. Clearly, the loan officer or mortgage lender is concerned with the sale price

versus the valuation (AVM). This fact is disclosed in Foretich in paragraph 6 and is

notoriously old and well known in the art. The loan to value comparison is very

important to the lender. It would have been obvious to one of ordinary skill in the art at

the time the invention was made to have the report contain both the AVM value and the

offer/sale price (which can be the same), so that the lender can see the valuation and

the loan value in one single report. This would have been obvious, especially in view of

the fact that these two numbers are what the lender is interested in when making the

decision on whether or not to give out a loan.

For claims 35, if weight is to be given to the content of the report, then not

disclosed is that the report contains a differential valuation for each property. Applicant

has claimed that the differential valuation is based on a difference between a property's

AVM (valuation) and an offering price for the property. Conceptually, this is a

comparison of the price that one is selling a home for, to the valuation value (AVM) for

that home. The examiner notes that paragraph 162 discusses the storing of AVM

values in the databases. Disclosed is that the valuations are stored *"for later use"* and

"for use in later valuations or other processes" and *"may be employed as comparables*

for later valuations as appropriate". This paragraph teaches the desirability of storing

the AVM value so that that AVM value can be used in later processing. Paragraph 15

also discusses the use of AVM values in further processing. The AVM value is a type of

data that a person of ordinary skill in the art is going to be concerned with. Anyone

buying a house or giving out a financial loan for a house is concerned with the value of

the house itself (valuation/AVM). That idea is just common sense and is something that

anyone who buys products of any kind recognizes. As a purchaser of a given product,

you take into consideration the sale price for the product and decide if that price is

acceptable for the "value" of the product that you are to receive. In other words, a

purchaser asks the question "is the product worth the price?". The importance of the

AVM value is also evidenced by paragraph 6, where it is disclosed that "*Since the loan*

to value ratio is of great significance to lenders in making loan decisions as well as in

determining applicable loan programs and interest rates, it is almost always necessary

for a property valuation to be undertaken in connection with the lending process." One

of ordinary skill in the art, such as a mortgage broker, is interested in the comparison of

the price for a given property to the value of that property. In this case, the loan value

for a mortgage lender is essentially the "offering price", as this is the price the seller is

willing to sell the property for and is the amount that the loan is for. The mortgage

lender is making a comparison of the offer for sale (loan value) value to the value of the

property, which is determined by the valuation process that is performed by server 90.

While this comparison is disclosed as being a ratio, it does teach the comparison of the

two claimed types of data (offer and AVM). The prior art and one of ordinary skill in the

art already recognize the importance of comparing the offer price to the valuation for

real estate property. It would have been obvious to one of ordinary skill in the art at the

time the invention was made to provide the report of Foretich with information on what

the difference is between a property's "offer for sale" price and the valuation value for

that property, that is also stored in the database. Both the offer price and AVM value

are going to be stored in the database. One of ordinary skill in the art at the time the

invention was made, taking into account the disclosure of Foretich, and taking into

account the level of knowledge that one of ordinary skill in the art is in possession of,

would have found it obvious to have the report contain the claimed differential valuation

that is a difference between the offer price and the valuation (AVM) that is stored in the

database as this is another way that one can compare the offer for sale to the AVM

value, the comparison of which is already recognized in the prior art. The lender is

concerned with a comparison between the offering price and the AVM value, which is

disclosed by Foretich, so for one of ordinary skill in the art to provide this desired

information in the report is considered to be obvious.

14.   Claims 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Foretich et al. (20030191723) and further in view of Florance et al. (20040030616).

        Not disclosed is that the display device is configured to provide information that

allows a remote terminal to render a map of a geographic region as is claimed.

Florance discloses a real estate system that provides users with real estate information

in response to search queries submitted by users. The query results are displayed to

the user in the form of maps, as is disclosed in paragraphs 347 and 348, and shown in

figure 58. These paragraphs disclose that the displayed maps allow for the display of the location of the property on a map by the use of icons and other indicators. Paragraph 348 states that when the user positions the computer mouse over an icon (that represents a property), *the system displays a pop-up window providing information on the associated property* (as best understood this satisfies "spatially embedded"). It is also disclosed that this feature allows the user to view the overall region in which the property is location (a desirable feature), as well as the ability to zoom in and out on the map of the property (another desirable feature). Florance teaches a very desirable manner by which the results of a property search query may be displayed to the user, namely the use of maps as claimed. In Foretich, the results of the submitted query are provided to the customer, it is just not disclosed that this is done by using a map as applicant has claimed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a map with pop up windows as is disclosed by Florance, so that the results of the query can be presented in a more user friendly format to the user, including the resulting AVM value. This is desirable because it would allow for the viewing of the overall region where the property is located, it would allow for the zooming in and out, as disclosed by Florance, as well as the convenient use of pop-up windows for the display of property related information, such as the AVM (see claim 83).

Double Patenting

15.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.   A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16.   Claims 32,33, are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over at least claim 1 of copending Application No. 11/432,515. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between the claims are obvious. Both claims recite an input device or a communication device as being configured to receive information. Both claims recite the ability to generate reports and are directed to a system that is providing an AVM value to a user. Applicant is claiming the same system in both applications, just with slightly different wording and slightly different scope. Currently pending claims are considered to be obvious in view of at least the '515 claim.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17.   Claims 32,33,34, are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over at least claims 1,2,3,of copending Application No. 10/536,691. Both sets of claims recite a system or apparatus that is for receiving user provided information. Both claims recite AVM values and are directed to a system that is providing an AVM value to a user. Applicant is claiming the same system in both applications, just with slightly different wording and slightly different scope.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

18.   Claims 32,33, are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over at least claims 75 of copending Application No. 10/536,692. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between the claims are obvious. Currently claims 32,33, are just a broader recitation of claim 75, which is considered to be obvious. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993). Deletion of an element from a claim is considered to be obvious and in this sense claim 1 is broader than claim 75 of '692 due to its failure to recite the
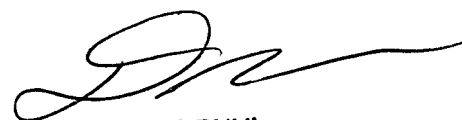
display device and the output device.   Currently pending claims are considered to be

obvious in view of at least the '692 claim.

        This is a <u>provisional</u> obviousness-type double patenting rejection because the

conflicting claims have not in fact been patented.

19.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808.

The examiner can normally be reached on Monday through Friday.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

        Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DENNIS RUHL
PRIMARY EXAMINER